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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210559
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NetCloud, LLC Opposer, v. **East Coast Network Services, LLC** Applicant.	)	Opposition No. **91210559**

OPPOSER'S MOTION FOR RECONSIDERATION OF FINAL DECISION

Pursuant to 37 C.F.R. § 2.129(c), Opposer Netcloud, LLC ("Opposer") hereby files this Motion for Reconsideration of Final Decision.

I. The Board Erred in Granting Applicant's Motion for Reconsideration of Final Decision and Dismissing Opposer's Notice of Opposition.

For the reasons set forth below, Opposer respectfully requests that the Board reconsider its decision granting Applicant's Motion for Reconsideration of Final Decision and dismissing Opposer's Notice of Opposition with prejudice.

A. The Board Erred in Striking the Exhibits Attached to Opposer's Reply Brief.

In its trial brief, Applicant asserted that "it was not provided any notice that would prompt Applicant to investigate, take discovery, and explore affirmative defenses such as abandonment regarding any usage of the NETCLOUD mark by Opposer's multiple purported predecessors-in-interest." Applicant's Trial Brief, 6.

As part of its reply brief, Opposer attached three separate exhibits showing that Applicant was on actual notice of Opposer's predecessors-in-interest. 15 TTABVue Exs. A-C. Exhibit A consisted of Opposer's Revised and Supplemental Responses to Applicant's First Set of

Interrogatories and Opposer's Supplemental Responses to Applicant's First Set of Requests for the Production of Documents and Things. *Id*. Exhibit B consisted of documents timely produced by Opposer to Applicant during discovery. *Id*. Exhibit C consisted of Opposer's Initial Disclosures. *Id*. In response to Opposer's reply brief, Applicant filed a Motion to Strike Exhibits Attached to Opposer's Reply Brief. 16 TTABVue.

In its original decision dated March 11, 2015, the Board granted Applicant's Motion to Strike Exhibits Attached to Opposer's Reply Brief. 19 TTABVue 6. The Board upheld striking the exhibits in its revised decision dated December 10, 2015. 26 TTABVue 2-3. In its original decision, the Board granted Applicant's motion for two reasons. The first reason was that "all evidence must be entered into the record during the trial period. As a result, any evidentiary matter not made of record during Opposer's trial period constitutes untimely evidence when submitted for the first time with Opposer's reply brief." 19 TTABVue 6.

In this case, the specific "evidentiary matter" as to whether Applicant was on notice of Opposer's predecessors-in-interest did not arise until *after* Opposer's trial period had closed. Specifically, the "evidentiary matter" arose when Applicant asserted in its trial brief that "it was not provided any notice that would prompt Applicant to investigate, take discovery, and explore affirmative defenses such as abandonment regarding any usage of the NETCLOUD mark by Opposer's multiple purported predecessors-in-interest." Applicant's Trial Brief, 6. Simply put, the "evidentiary matter" was not in existence at any time during Opposer's trial period. Surely, Opposer cannot reasonably be expected to enter into the record evidence on an evidentiary matter not yet in existence and not directly related to its case-in-chief (i.e. priority and likelihood of confusion).

The second reason the Board granted Applicant's Motion to Strike Exhibits Attached to Opposer's Reply Brief was because "Opposer cannot make of record its own Responses to Interrogatories (except under limited circumstances not applicable here), Responses to Requests for Documents, and Initial Disclosures." 19 TTABVue 6.

Opposer wholeheartedly agrees with the Board that Opposer cannot make of record such documents. In fact, 37 C.F.R. § 2.120(j)(5) clearly states that, except in limited circumstances not relevant here, "written disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the ***record*** only by the receiving or inquiring party." (emphasis added). The word "record" must logically refer to the evidentiary record made during a party's trial period since there is no other "record" in a TTAB opposition proceeding. The "record" is made *before* any briefs are filed with the Board. The parties' briefs ordinarily refer to the "record," but the briefs and any attachments thereto are certainly not part of the "record" themselves.

Without question, Opposer did not violate 37 C.F.R. § 2.120(j)(5). While it is clear from the rule that only the receiving or inquiring party may submit and make part of the record the documents specified in the rule, there is absolutely nothing in the plain language of 37 C.F.R § 2.120(j)(5) that prohibits the non-receiving or non-inquiring party from using the specified documents in a manner other than making them "part of the record."

In this case, Opposer never attempted to make the three exhibits attached to its rely brief part of the record during its trial period. Opposer never used the three exhibits during its trial period to bolster, support, or corroborate its claims of priority and likelihood of confusion set forth in its Notice of Opposition. In fact, due to the nature of the exhibits, Opposer *could not* have made them part of the record because Opposer was not the "receiving or inquiring party."

Rather, Opposer attached the three exhibits to its reply brief for the sole and express purpose of addressing the evidentiary matter first introduced by Applicant in its trial brief and impeaching Applicant's claim that it was not on notice of Opposer's predecessors-in-interest.

In view of the fact that the exhibits to Opposer's reply brief did not violate 37 C.F.R. § 2.120(j)(5), Opposer respectfully requests that the Board reverse its decision to strike the exhibits and to consider such exhibits solely for impeachment purposes.

B. The Board Erred in Granting Applicant's Motion for Reconsideration Because Applicant Was On Actual Notice of Opposer's Predecessors-In-Interest.

In its Motion for Reconsideration, Applicant argued that Opposer was obligated to explicitly plead use of the NETCLOUD mark by its predecessors-in-interest in order to meet the notice pleading requirements of Rule 8(a)(2) of the Federal Rules of Civil Procedure. 20 TTABVue 1. In its decision granting Applicant's Motion for Reconsideration, the Board stated that "we find that Opposer's trial tactics contravene notice pleading requirements of the modern federal rules of appellate and civil procedure." 26 TTABVue 7. As a result, the Board struck all testimony of Raj Viradia and Mehul Satasia, as well as all exhibits introduced by these witnesses at trial. *Id*. at 8-9.

Applicant strongly disagrees with the Board's finding for a variety of reasons. First, the Board pointed to no case, rule, or statute explicitly requiring an opposer to plead use of a mark by its predecessors-in-interest in order to meet the pleading requirements for a notice of opposition based on §2(d). Such a requirement would make little sense in the context of an opposition where priority is the primary issue because it is irrelevant at the pleading stage *how* the opposer obtained priority in its mark. Whether or not the opposer's claim of priority is based on its own use or on use by a legitimate predecessor-in-interest, such a fact does not alter the way in which the defendant would answer or defend the opposition. Either way, the defendant is

fully aware of the opposer's claim of priority and has every opportunity to thoroughly explore the basis for the opposer's claim during the discovery period in order to determine how and whether the opposer possesses the requisite priority. In other words, use of a mark by the opposer's predecessor-in-interest is not a material fact at the pleading stage.

Second, in order to properly assert priority, an opposer need only allege facts showing proprietary rights in its pleaded mark that are prior to defendant's rights in the challenged mark. TBMP § 309.03(c). In this case, Opposer alleged in its Notice of Opposition that "[s]ince long before any date on which Applicant could reasonably rely, Opposer has been continuously using the trademark NETCLOUD in commerce in connection with cloud virtual private server (cloud VPS) services and cloud hosting services." Notice of Opposition, ¶ 1. Opposer also alleged that it "is the owner of all right, title, and interest in and to the NETCLOUD trademark as used in connection with its services." Notice of Opposition, ¶ 4. Moreover, Opposer alleged that "its use of its NETCLOUD trademark in connection with its services precedes the filing date of Applicant's application for NETCLOUD, as well as the dates of first use as alleged by Applicant in its application." Notice of Opposition, ¶ 7. These statements are non-misleading, completely accurate, and give fair notice to Applicant that Opposer is alleging priority based on actual service mark usage.

Third, in this specific case, Applicant was on *actual notice* of Opposer's witnesses and predecessors-in-interest Mehul Satasia and Raj Viradia. 15 TTABVue Exs. A-C. Applicant also had documents in its possession early in the discovery period showing the purported transfer of the NETCLOUD mark from Raj Viradia to Mehul Satasia, and then from Mehul Satasia to Opposer. *Id.*

In view of the above, Opposer respectfully requests that the Board reconsider its decision to strike the testimony of Raj Viradia and Mehul Satasia, as well as all exhibits introduced by these witnesses at trial.

Respectfully submitted,

NETCLOUD, LLC

By:_____/met20/_____ Dated:_____1/11/2016____

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served by emailing said copy on_____1/11/2016_____to:

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_____/met20/_____
Morris E. Turek, Attorney for Opposer